

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed May 5, 2005. Applicant respectfully requests reconsideration and favorable action in this case in view of the following remarks.

Section 103(a) Rejections

The Office Action rejects Claims 1-37 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,119,128 issued to Counter et al. (“*Counter*”), in view of U.S. Patent No. 5,565,316 issued to Kershaw et al. (“*Kershaw*”). Applicant respectfully traverses these rejections for the reasons discussed below.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP § 2143.

With reference to the independent Claims 1, 8, 13, 20, 27, 28, 31, 34 and 37, Applicant respectfully submits that the Examiner has not provided the required evidence of a motivation to combine *Counter* and *Kershaw*. As mandated by the federal circuit, “a factual inquiry whether to combine references must be thorough and searching.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Any “conclusory statements . . . do not adequately address the issue of motivation to combine.” *Id.* The Examiner simply states at page 3 of the Office Action that “it would have been obvious to one [of] ordinary skill in the art at the time the invention was made to modify Counter’s system to include creating the log as the backup of the other log as taught by Kershaw in order to utilize the backlog to restore when the other log has failed.” However, the *Kershaw* system is directed towards a system and method for computer-based testing and to the best of Applicant’s knowledge does not teach or suggest any restoring of a database. More specifically, the passage cited by the Examiner at column 15, lines 37-44 merely states:

“The second log file created by IEG is the Batch History File, which contains the accession numbers of all items in the offload file. This file is named using an input file name and .BHF extension such as input file.BHF. Accession numbers are preferably written to the file in ASCII format, one

per line, in the order in which they were processed. Accession numbers of the set may be written to the file one after the other, starting with the stimulus material."

This paragraph states nothing about restoring of a database by copying data from a secondary storage device to a primary storage device, as is disclosed in *Courter*. *Courter* as understood by Applicant relates to a method, system and article of manufacture for a computer implemented recovery system for restoring a database on a computer. Objects of different types in the database are copied from a primary data storage device to a secondary data storage device. Modification of the objects are logged in a log file. A recovery indicator indicates the recovery is required and the objects are copied from the secondary data storage device to the database on the primary storage device. Modifications in the log file are applied to the copied objects during one pass through the log file. Thus, one having ordinary skill in the art would not be motivated to combine *Courter* and *Kershaw*. The Examiner offers no technical reasoning as to how these references could be combined and, if combined, would be successfully combined. Applicant respectfully submits that the Examiner's reasoning surely cannot be said to be "thorough and searching."

Therefore, Applicant submits that one having ordinary skill in the art would not be motivated to combine *Courter* and *Kershaw*. Thus, a *prima facie* case of obviousness has not been established and independent Claims 1, 8, 13, 20, 27, 28, 31, 34 and 37 are allowable.

In addition to being allowable for the above reasons, independent Claims 1, 8, 13, 20, 27, 28, 31, 34 and 37 are also allowable because each and every limitation of these claims is not taught or suggested by the *Courter-Kershaw* combination. For example, with respect to Claim 1, neither *Courter* nor *Kershaw*, alone or in combination, teaches or suggests "creating a log file, the contents of the log file being limited to a subset of all log records." And with respect to Claim 8, neither *Courter* nor *Kershaw*, alone or in combination, teaches or suggests "storing the log record in a second log file recording all changes." The Examiner admits that *Courter* does not explicitly teach these limitations and attempts to use *Kershaw* to teach these limitations. However, as evidenced the paragraph cited at column 15, lines 37-44 of *Kershaw* outlined above, nowhere is it taught or suggested that a log file is created that has contents being limited to a subset of all log records, nor storing a log record in a second log file recording all changes. The Applicant directs the Examiner to column 13, line 33 through column 15, line 56, which explains the Item Preparation aspect of the *Kershaw* system and

more specifically, the Item Offload Program. For at least these additional reasons, independent Claims 1, 8, 13, 20, 27, 28, 31, 34 and 37 are allowable. Reconsideration and favorable action are respectfully requested.

Dependent Claims 2-7, 9-12, 14-19, 21-26, 29-30, 32-33 and 35-36 are also not rendered obvious by the *Courter-Kershaw* combination proposed by the Examiner because they include the limitations of their respective base claim as well as additional limitations that further distinguish *Courter* and *Kershaw*. Reconsideration and favorable action are respectfully requested.

CONCLUSIONS

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other apparent reasons, Applicant respectfully requests full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

Applicant hereby takes a one (1) month extension of time for responding to the Office Action dated May 5, 2005. A separate Notification of Extension of Time along with a check in the amount of \$120.00 is attached hereto.

Applicant believes no other fees are currently due. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge any required fees or credit any overpayments to Deposit Account No. **02-0384** of **Baker Botts L.L.P.**

Respectfully submitted,

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